

REMARKS

Claims 1, 2, 4-6, 7, 8, 9, 11-14, 15, 16, 18, 19 and 21-23 were pending and were rejected by the Examiner. Claims 1, 5, 6, 8, 12, 13, 15, and 21-23 have been amended. Accordingly, claims 1, 2, 4-9, 11-16, 18, 19, and 21-23 are pending and at issue. Applicant submits that claims 1, 2, 4-9, 11-16, 18, 19, and 21-23 are in condition for allowance and requests reconsideration and withdrawal of the outstanding rejections. No new matter has been entered.

Rejections Under 35 U.S.C. §103(a)

The Examiner rejected claims 1-2, 4-6, 8-9, 11-19, and 21-23 under U.S.C. §103(a) as being unpatentable over Mun (US Pub. No 2003/0022659) in view of Hwang (US Pub. No 2003/0092432). Applicant traverses this rejection for the following reasons.

The foregoing rejection is traversed for the following reasons. Applicant respectfully submits that the obviousness rejection based on Mun and Hwang is improper as Mun and Hwang fail to teach or suggest each and every element of the instant invention in such a manner so as to perform as the claimed invention performs. For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a prima facie case of obviousness. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). The Examiner must meet the burden of establishing that all elements of the invention are taught or suggested in the prior art. MPEP §2143.03.

Even if the teachings of Mun and Hwang are combined, the resulting combination fails to meet Applicant's claimed invention. Amended claim 1 now recites "selecting all information elements associated with the originator terminal by retrieving the information elements from a network database based upon the service plan and the terminal capability of the recipient terminal". Similarly, amended claim 8 now recites "selecting all information elements associated with the originator terminal from a network database by retrieving the information elements based upon the service plan and the terminal capability of the recipient terminal". Likewise, amended claim 15 now recites "selecting all information elements

associated with the originator terminal from the network-based originator communications information database by retrieving the information elements based upon the service plan and the terminal capability of the recipient terminal”. No new matter has been entered by this amendment. Support may be found throughout the Applicant’s Specification and Figures (e.g., Figure 3 provides “Query SPD with RT address ‘1235551214’” in response to a “Voice call to RT” with arrow from Switch/Router to the service profile database (SPD); Figure 3 also illustrates “Service profile for RT retrieved from SPD via the arrow to the Switch/Router). As recited in claim 1, and as shown throughout Figure 3, the information elements of the communication are derived by retrieving a service profile for a recipient terminal using the recipient terminal’s address (i.e., the address resulting from initiation of the communication), and transmitting the communication and information elements based upon the service plan and terminal capabilities of the recipient terminal.

Mun merely discloses techniques for providing a *picture* as caller identification. (Caller ID). A mobile switching center (MSC) stores picture information for a first mobile station (MS). When the first MS calls a second MS, the MSC transmits the stored picture information of the first MS to the second MS such that this picture information can be displayed as the Caller ID on a display mechanism of the second MS. This functionality is discussed, for example, in paragraph [0008] of Mun.

The Examiner indicates that “Mun does not specifically disclose selecting two or more information elements by retrieving two or more information elements from a network database wherein the information elements include advertising material.” Thus, the Examiner relies upon Hwang in an effort to supply the features missing from Mun. However, neither Mun nor Hwang discloses or suggests selection of all enhanced originator information based upon the service plan and the terminal capability of the recipient terminal as set forth in Applicant’s claims 1, 8, and 15 as amended. Throughout Mun’s specification and claims, reference is made only to a picture caller ID (PCID). No reference is made to a comprehensive originator identification that includes at least two different types of information elements as called for in Applicant’s claimed invention.

Thus, Mun clearly does not disclose or suggest selection of all enhanced originator information based upon the service plan and the terminal capability of the recipient terminal.

Hwang discloses information elements that include advertising material for the purpose of providing caller ID messages in conjunction with advertisements. Refer, for example, to paragraph [0029] of Hwang. However, Hwang fails to disclose or suggest selection of all enhanced originator information based upon the service plan and the terminal capability of the recipient terminal as set forth in Applicant's claims 1, 8, and 15 as amended.

For the foregoing reasons, Applicant's claimed invention as set forth in independent claims 1, 8, and 15 is patentable over Mun and Hwang. It is further submitted that claims 1, 8, and 15 are allowable over the prior art of record. With respect to dependent claims 2, 9 and 16 as applied to claims 1, 8, and 15, Applicant respectfully submits that since independent claims 1, 8, and 15 are allowable over the prior art of record, then it follows that dependent claims 2, 9 and 16 are also allowable.

With respect to claims 4, 11, and 18 as applied to claims 1, 8, and 15, Applicant respectfully submits that since independent claims 1, 8, and 15 are allowable, then it follows that dependent claims 4, 11, and 18 are allowable.

With respect to claims 5 and 12 as applied to claims 1 and 8, Applicant respectfully submits that since independent claims 1, 8, and 15 are allowable, then it follows that dependent claims 5 and 12 are allowable.

With respect to claims 6, 13, and 19 as applied to claims 1, 8, and 15 above, Applicant respectfully submits that since independent claims 1, 8 and 15 are allowable, then it follows that dependent claims 6, 13, and 19 are allowable.

With respect to claims 7 and 14 as applied to claims 1 and 8 above, Applicant respectfully submits that since independent claims 1 and 8 are allowable, then it follows that dependent claims 7 and 14 are allowable.

With respect to claims 21, 22, and 23, Applicant respectfully submits that since independent claims 1, 8 and 15 are allowable, then it follows that dependent claims 21, 22 and 23 are allowable.

In view of the foregoing, Applicant submits that Mun and Hwang fail to teach or suggest each and every element of the claimed invention and are therefore wholly inadequate in their teaching of the claimed invention as a whole, fail to motivate one skilled in the art to do what the patent Applicant has done, fail to recognize a problem recognized and solved only by the present invention, fail to offer any reasonable expectation of success in combining the References to perform as the claimed invention performs, fail to teach a modification to prior art that does not render the prior art being modified unsatisfactory for its intended purpose, and disclose a substantially different invention from the claimed invention, and therefore cannot properly be used to establish a prima facie case of obviousness. Accordingly, Applicant respectfully requests reconsideration and withdrawal of all rejections under 35 U.S.C. §103(a), which Applicant considers to be traversed.

Summary

For at least the foregoing reasons, the Applicant submits that all pending claims are in condition for allowance and respectfully requests reconsideration and withdrawal of the outstanding rejections.

CONCLUSION

It is believed that the foregoing amendments and remarks fully comply with the Office Action and that the claims herein are allowable. Accordingly, reconsideration and allowance is requested.

If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 06-1130.

Respectfully submitted,

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